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THE DEVELOPMENT OF THE LAW OF INTELLECTUAL PROPERTY AND CREATIVE ARTS IN THE WESTERN STATES

By LEON R. YANKWICH*

Introduction

Law, whatever its form, arises out of human needs. Before law finds expression in legislative enactment or judicial decisions, human relations must exist to which legal norms can apply. Except where, through conquest and colonization, a legal system is imposed upon a community from the outside, all law, ultimately, stems from communal needs which the legislator and jurist have formalized.¹

The variety of those needs derives from the diversity of activities. In the United States, they account for the fact that, despite the uniform basis of our civilization, the different development of the states and regions have resulted in distinct systems of jurisprudence and, in many instances, in a difference in emphasis on principles within the common law pattern. Even in the application of principles of general nature and of ideas or legal norms embodied in federal legislation, the incidence of certain economic and social activities in certain parts of the United States have led to the development of a jurisprudence that is strictly localized. Because the publishing of books and works of literature, art and science, has been, and, to a great extent, still is, confined to the Eastern Coast, and the original publication and production of dramatic works, in the past, has been confined to the State of New York, the exposition of the legal principles relating to proprietorship in ideas, whether stemming from common law principles or the law of copyright, was restricted to the courts of that state and of the Eastern Coast. With the artistic development of the West, and, especially, with the advent, first of the motion picture, then of the talking picture, and later, of television and kindred arts, and their unfoldment on the Pacific Coast, the courts of that area began to be called upon more and more to determine problems in the realm of proprietorship of ideas, copyright and contractual rights pertaining to the relationship arising out of theatrical and motion picture production which, in the past, had been the sole *appanage* of the Eastern Coast. So it is the object of this study to show how the courts in the Western States comprising the Ninth Circuit (Arizona, California, Idaho, Montana, Nevada, Oregon and Washington), both federal and state, have applied the law of literary property and other legal principles relating to literature, drama and art as the West "has grown up."²

* Chief U. S. District Judge, Southern District of California.

¹ MAX WEBER, *LAW IN ECONOMY AND SOCIETY* 65 *et seq.*, (1954); Yankwich, *The Scholar and the Law*, 46 *THE BRIEF, PHI DELTA PHI QUARTERLY* 193 (1951).

² In this respect the *RESTATEMENT, CONFLICT OF LAWS* § 3 (1934) defines law as "... the body of principles, standards and rules which the courts of a particular state apply in the decision of controversies brought before them."

I. *The Law of Literary Property*

The common law recognized a property right in the products of man's creative mind regardless of the form in which they took expression. For this reason and without regard to copyright, literary property is given the same recognition as other personal property. An author will be protected in the right to his manuscript until he permits general publication.

The Western States in which the problem has arisen recognize this property right.³ A late California case has stated its nature very succinctly: "A product of the mind is property. . . . It is an intangible incorporeal right."⁴ Other California cases, preceding and following it, have reasserted this principle,⁵ which has also been recognized by Washington courts.⁶ The Washington case just referred to shows the extent to which the courts will go in protecting property rights to the original expression of ideas. For in it, the phrase "The Beer of The Century," which had been suggested by the plaintiffs, was given protection.⁷

Generally, the courts extend the protection *not* to ideas, but to the concrete forms in which they are embodied.⁸ Whatever deviation there may have been from this principle in some California cases,⁹ the latest California cases¹⁰ have restored the law so that it accords with the general law on the subject.¹¹

³ CALIF. CIV. CODE §§ 654, 655, 980. With commendable consistency the California courts have recognized the right to an unpublished work and sustained bequests of identifiable unpublished manuscripts. See, *Estate of White*, 84 Cal.App.2d 409, 190 P.2d 968 (1948). In the particular case, the transfer proved illusory because, although in an action before me, I held that there had been only a limited publication of the manuscript [*White v. Kimmell*, 94 F. Supp. 502 (S.D. Cal. 1950)], the Court of Appeals disagreed with the conclusion and held that the publication was general, and, therefore, in the public domain. *White v. Kimmell*, 193 F.2d 744 (9th Cir. 1952). See, Schlachtmann, *The Doctrine of Limited Publication*, 5th Copyright Law Symposium (ASCAP), 1954, p. 57.

⁴ *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal.App.2d 796, 808, 187 P.2d 474, 482 (1947).

⁵ *Burtis v. Universal Pictures*, 40 Cal.2d 823, 256 P.2d 933 (1953); *Kurlan v. Columbia Broadcasting System*, 40 Cal.2d 799, 256 P.2d 962 (1953); *Weitzenkorn v. Lesser*, 40 Cal.2d 778, 256 P.2d 947 (1953); *Loew's, Incorporated v. Superior Court*, 18 Cal.2d 419, 115 P.2d 983 (1941); *Yadkoe v. Fields*, 66 Cal.App.2d 150, 151 P.2d 906 (1944); *Italiani v. Metro-Goldwyn-Mayer Corp.*, 45 Cal. App.2d 464, 114 P.2d 370 (1941); *Richardson v. Hislop*, 109 Cal.App. 440, 293 Pac. 168 (1930).

⁶ *Ryan & Associates, Inc. v. Century Brewing Ass'n*, 185 Wash. 600, 55 P.2d 1053 (1936), cited with approval in *Johnston v. Twentieth Century-Fox Film Corp.*, *supra* note 4 at 814, 187 P.2d at 485.

⁷ This contrasts with the attitude of one of the California courts which, while enunciating the principle that a scenario is what the law designates as "an intellectual product," observed rather sarcastically that "in some instances this may be a misnomer." *Italiani v. Metro-Goldwyn-Mayer*, 45 Cal.App.2d 464, 466, 114 P.2d 370, 372 (1941).

⁸ *Johnston v. Twentieth Century-Fox Film Corp.*, *supra* note 4; *Barsha v. Metro-Goldwyn-Mayer*, 32 Cal.App.2d 556, 90 P.2d 371 (1939).

⁹ *Golding v. R.K.O.*, 35 Cal.2d 690, 221 P.2d 95 (1950); *Stanley v. Columbia Broadcasting System*, 35 Cal.2d 653, 221 P.2d 73 (1950).

¹⁰ CALIF. CIV. CODE § 980(a), as amended in 1947; *Burtis v. Universal Pictures*, 40 Cal.2d 823, 256 P.2d 933 (1953); *Kurlan v. Columbia Broadcasting System*, 40 Cal.2d 799, 256 P.2d 962 (1953); *Weitzenkorn v. Lesser*, 40 Cal.2d 778, 256 P.2d 947 (1953).

¹¹ See, Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457 (1951); Nimmer, *The Law of Ideas*, 27 So. CAL. L. REV. 120 (1954); Note, *Literary Property*, 38 CAL. L.

Procedural methods need not detain us. It suffices to say that when there is unauthorized use, the courts allow recovery upon the theory of an implied agreement to compensate for the use or damage from unauthorized use. And the protection will extend to expressions showing very little originality, so long as there is some originality in the combination of ideas, or in their concrete embodiment.¹²

And so, in determining the existence or non-existence of similarity from which an inference of plagiarism can be drawn, the courts apply the commonly accepted test of impression by the average reader or viewer and forbid the substitution of the judgment of the expert analyst. The trier of facts is thus permitted to draw inferences of plagiarism from the similarity of the materials arising from details, sequence of events, manner of expression, and treatment.¹³ Moreover, where the material is of a character as to which no proprietary right could be exercised, such as the title to a work, the courts will, nevertheless, forbid its use by another as unfair competition. This is illustrated by the case in which the originators of a method of supplying credit information were protected against competitors.¹⁴

And the Supreme Court of California has sustained an award of \$17,500 for use of the title of a play which, although produced, had proved unsuccessful. Conceding that the author of a play has no "inherent right in the title to his production," the court, nevertheless, held that through the advertising which preceded and followed the staging of the play, the title had acquired a secondary meaning and had attained "a protective status."¹⁵ The Western courts have also recognized a person's right "to himself"—the right of privacy—the right "to be let alone."¹⁶

REV. 332 (1950); Note, *Common Law Copyright*, 24 So. CAL. L. REV. 65 (1950); Note, *Literary Property in Ideas*, 20 So. CAL. L. REV. 371 (1947). And see, Webster, *Protecting Things Valuable—Ideas*, 5th Copyright Law Symposium (ASCAP), 1954, p. 158; Young, *Plagiarism, Piracy and the Common Law Copyright*, 5th Copyright Law Symposium (ASCAP), 1954, p. 205.

¹² *Borden & Barton v. Warner Bros.*, 99 Cal.App.2d 760, 222 P.2d 463 (1950).

¹³ *Burtis v. Universal Pictures*, 40 Cal.2d 823, 256 P.2d 933 (1953); *Barsha v. Metro-Goldwyn-Mayer*, 32 Cal.App.2d 556, 90 P.2d 371 (1939). This accords with the federal rule to the effect that originality is a question of fact and not of law. *Dezendorf v. Twentieth Century-Fox Film Corp.*, 99 F.2d 850 (9th Cir. 1938). Under a 1947 statute (CALIF. CODE OF CIV. PRO. § 426(3)), a plaintiff in an action for plagiarism is required to attach a copy of the original and of the pirated production, and the court may order a view in passing on the sufficiency of the complaint. This has enabled California state courts to determine absence of similarity without a trial. See, *Palmer v. Metro-Goldwyn-Mayer*, 119 Cal.App.2d 456, 259 P.2d 741 (1953); *Sutton v. Walt Disney Productions*, 118 Cal.App.2d 598, 248 P.2d 599 (1953).

¹⁴ *McCord v. Plotnick*, 108 Cal.App.2d 392, 239 P.2d 32 (1951).

¹⁵ *Jackson v. Universal International Pictures*, 36 Cal.2d 116, 121, 222 P.2d 433, 436 (1950). California courts have prohibited as unfair competition the imitation of the established characterization of an actor; *Chaplin v. Amador*, 93 Cal.App. 358, 269 Pac. 544 (1928) ("little tramp" identified with Charles Chaplin); *Jones v. Republic Productions*, 112 F.2d 672 (9th Cir. 1940) (the "Lone Ranger" and his horse "Silver"); and the use of a business name similar to one associated with a group organized to advance the motion picture arts; *Academy of Motion Picture Arts and Sciences v. Benson*, 15 Cal.2d 684, 104 P.2d 650 (1940).

¹⁶ *Mau v. Rio Grande Oil Co.*, 28 F. Supp. 845 (N.D. Cal. 1939); *Reed v. Real Detective Publ. Co.*, 63 Ariz. 294, 162 P.2d 133 (1945); *Gill v. Hearst Pub. Co.*, 40 Cal.2d 224, 253 P.2d 441

But what is more important, in view of the expansion of the media of communication through radio, motion pictures and television, is that the courts have held that the right of privacy is not absolute, but is limited to persons *who are not* public figures. As to persons who are in the public eye or matters which are of public concern, the invasion of privacy through publication of photographs or other non-defamatory matter is permitted.¹⁷

One of the late California cases on the subject has summed up the two facets of this problem in this manner:

"The so-called independent right of privacy which is recognized in this state is not an absolute right 'to be let alone' and to live one's life in utter privacy freed at all times from the prying eyes of the public or of a public recountal of the facts thereof. The right of the individual to privacy of his 'private' life is a limited right in that it is always subject to the right of the public to a disclosure thereof where there is a proper warranted public interest as to the facts of his life. The dividing line between the individual right and the so-called public right is not easily drawn and must be determined in every instance by the facts of each case. The general test, in large measure, is whether the public interest in obtaining or having disclosed to it the information outweighs the protection of the individual's personal interest and desires."¹⁸

The courts, in this respect, have followed the trend observable elsewhere of striking an equitable balance between individual rights and public needs, thus illustrating once more the capacity for adaptation of our legal system.¹⁹

II. *The Obedience of the Artist*

The development of the motion picture and kindred arts and the concentration of their activities on the Pacific Coast have affected the contractual relations between the persons engaged in those activities. The special nature of the services of a motion picture artist led to the incorporation into the California law in 1919 of the provision allowing the issuance of injunctions to prevent the breach of a contract:

"... where the promised service is of a special, unique, unusual, extraordinary or intellectual character which gives it peculiar value the loss of which cannot be reasonably or adequately compensated in damages in an action at law."²⁰

(1953); Gill v. Curtis Pub. Co., 38 Cal.2d 273, 239 P.2d 630 (1952); Kirby v. Hal Roach Studios, 53 Cal.App.2d 207, 127 P.2d 577 (1942); Metter v. Los Angeles Examiner, 35 Cal.App.2d 304, 95 P.2d 491 (1939); Melvin v. Reed, 112 Cal.App. 285, 297 Pac. 91 (1931); Hinish v. Meyer & Frank Co., 166 Or. 482, 113 P.2d 438 (1941); Hillman v. Star Publishing Co., 64 Wash. 691, 117 Pac. 594 (1911). See, Yankwich, *The Right of Privacy*, 27 NOTRE DAME LAW. 499 (1952).

¹⁷ Samuel v. Curtis Pub. Co., 122 F. Supp. 327 (S.D. Cal. 1954); Coverstone v. Davies, 38 Cal.2d 315, 239 P.2d 876 (1952); Stryker v. Republic Pictures Corp., 108 Cal.App.2d 191, 238 P.2d 670 (1951); Cohen v. Marx, 94 Cal.App.2d 704, 211 P.2d 320 (1949).

¹⁸ Stryker v. Republic Pictures Corp., *supra* note 17 at 194, 238 P.2d at 671.

¹⁹ In the early days of talking pictures, it was determined that a writer who sold the "motion picture, dramatic and spoken stage rights" of his novels had conveyed the right to produce *talking pictures*. Rosenberg & Lesser v. Wright, Copyright Office Bulletin No. 20, p. 599 (1934). See, Murphy v. Warner Bros. Pictures, 112 F.2d 746 (9th Cir. 1940).

²⁰ CALIF. CODE OF CIV. PRO. § 526(5).

This is a deviation from the general equitable rule embodied in the same section that no injunction will issue to prevent the breach of a contract for personal services.²¹ As if to protect motion picture companies from temperamental *juvenile* stars, the California legislature, in 1927, amended the provision allowing disaffirmance of contracts by minors by including in the list of contracts *not* disaffirmable:

A contract or agreement employing such person as, or wherein such person agrees to perform or render services as, an actor, actress, or other dramatic performer, or as a participant or player in professional sports, including, but without being limited to, professional boxers, professional wrestlers and professional jockeys, where such contract or agreement has been approved by the superior court in the county in which such minor resides or is employed.²²

The Supreme Court of California has extended this provision not only to the contract entered into through the court, but to the options under it. And it could see no constitutional objection to limiting the right to minors engaged in certain professions only, saying:

"It can hardly be questioned that there are reasonable grounds for the statutory provisions withdrawing the right of disaffirmance from minors with regard to contracts to render services in the professions specified in section 36, if such contracts are found reasonable by a court in a special proceeding for the examination thereof. Whether certain other groups of minors engaged in professions similar to those specified in section 36 should be included in the section is a matter of legislative discretion. New legislation such as this ordinarily first covers the fields where it is most urgently needed, and may be extended in the light of experience. . . . The statute therefore does not violate constitutional rights of the defendant under the equal protection of laws clause of the United States Constitution or under the provisions of the California Constitution against special legislation."²³

Aside from legislative enactments, the courts in applying the law of master and servant have had to take into consideration the peculiar nature of the motion picture art and the temperament of the persons engaged in it. In a California case the court was called upon to determine whether a motion picture company was justified in discharging an actress, under contract, for failing to report for work at a definite hour set by the studio. Although the matter was not specifically covered by the written contract, the court held that the order to report was a reasonable one, of the type that the actress was bound to obey, under penalty of discharge, saying:

"Any 'willful' disobedience of an order that is reasonable and not inconsistent with the contract of employment is sufficient to justify the

²¹ CALIF. CIV. CODE § 3423; *Poultry Producers v. Barlow*, 189 Cal. 278, 208 Pac. 93 (1922). Elsewhere, contracts for personal services are limited to seven years: CALIF. LABOR CODE § 2855; *De Haviland v. Warner Bros. Pictures*, 67 Cal.App.2d 225, 153 P.2d 983 (1944).

²² CALIF. CIV. CODE § 36 (2).

²³ *Warner Bros. Pictures v. Brodel*, 31 Cal.2d 766, 777, 192 P.2d 949 (1948).

servant's discharge. (Civ. Code, Sec. 2000) 'Willful' disobedience of a specific, peremptory instruction of the master, if the instruction be reasonable and consistent with the contract, is a breach of duty—a breach of the contract of service; and, like any other breach of the contract, of itself entitles the master to renounce the contract of employment. According to the decided preponderance of authority, a single act of disobedience to a specific, reasonable order from the master to the servant is, as a matter of law, a violation of duty that justifies the master in discharging; . . . and whether actual injury has resulted to the master's business is wholly beside the mark. . . . The motive of the master in giving the order is not important. Whether the order is reasonable is the important question. The master has the right to make a reasonable order though he knows it will be distasteful to the servant, and even though he gives the order with the expectation that the servant will leave his employ rather than obey."²⁴

But in a later case,²⁵ which arose in the Superior Court of Los Angeles while I was on the bench, the ruling was modified. I was called upon to determine whether "arguing" with directors as to the manner in which scenes should be acted was the type of disobedience for which an actress could be discharged, after performance by her had been accepted. The person involved was Jetta Goudal, a motion picture actress of the silent screen who was discharged by her employer for several alleged acts of disobedience: (1) absences; (2) failure to perform *when* requested; (3) *as* requested; or (4) *conscientiously* or to the best of her ability; or (5) *as exclusively* directed by defendant, and in accordance with its ideas and instructions; and (6) delay of production through tardiness.

In sum, the disobedience charged consisted chiefly of arguments with directors about the manner of acting certain scenes, refusal to act as directed, and tardiness. The contract of employment provided:

"The Artist . . . shall perform her said services at all times and places, during the day and night, and in the manner required or directed by the producer, either in the state of California or elsewhere, and under and in accordance with the exclusive direction, control and ideas and instruction of the Producer, through its officers, agent or agents, and shall render said services conscientiously, artistically and to the utmost of her ability."

While this clause subjected the artist to the direction of the employer, I considered the added clause that the work performed *be artistically done*,

²⁴ May v. New York Motion Picture Corp., 45 Cal.App. 396, 403, 187 Pac. 785, 788 (1920). Similarly, the refusal of a director to report on two consecutive days in violation of a studio rule was held to be ground for discharge: Bank of America v. Republic Productions, 44 Cal.App.2d 651, 112 P.2d 972 (1941). However, where an actress held herself in readiness for work but was not called, she was allowed to recover the "minimum compensation" guaranteed, deducting from it amounts earned by other work; De las Falaise v. Gaumont-British Pictures Corp., 39 Cal.App.2d 461, 103 P.2d 447 (1940); Payne v. Pathe Studios, 6 Cal.App.2d 136, 44 P.2d 598 (1935). Where the meaning of "minimum compensation" is uncertain, parol evidence as to its meaning should be admitted: R.K.O. Pictures v. Sheridan, 195 F.2d 167 (9th Cir. 1952).

²⁵ Goudal v. DeMille Picture Corp., (Calif. Superior Court) Los Angeles Journal, Mar. 19, 20, 1929.

as indicating that, in determining what is or is not disobedience, the general nature of the employment to which the contract relates, and the capabilities which the actress was known to possess, and with regard to which the contract was made, had to be taken into consideration. The very preamble to the contract was an acknowledgement of this fact:

"The Artist, for several years immediately last past, has been engaged as an actress in the production of motion pictures, and is possessed of, and represents that, the services to be performed by her, hereunder, are of a *special, unique, unusual, extraordinary, and intellectual* character, which gives them peculiar value." (Emphasis added.)

In an employment of this character, obedience of the type stressed in Alfred Lord Tennyson's *The Charge of the Light Brigade*,

"Theirs not to make reply
Theirs not to reason why
Theirs but to do . . ."

is not required. So, in considering whether there was wilful disobedience, the nature of the orders given as well as the effect of refusal to obey must be taken into consideration. Admittedly, a contract of employment implies an obligation on the part of the servant to obey, substantially, the lawful and reasonable commands of his master.²⁶ A refusal to obey which, in view of all the circumstances of the case, amounts to insubordination, and is inconsistent with the servant's duties to his master, is a valid ground for discharge.²⁷ Given the great variety of employments, what, in a specific instance, amounts to insubordination (or "wilful breach of duty," as it was called in section 2000 of the California Civil Code, now section 2924 of the California Labor Code), is dependent upon the nature of the employment, the position of the servant, and the nature of the command. From one occupying a supervisory capacity or an employment requiring the exercise of great proficiency, the law does not demand or expect the slavish obedience of an unskilled workman.²⁸ Nor can a highly skillful employee be required to perform services of an inferior or less important character.²⁹

In view of the special nature of theatrical services, and the high

²⁶ CALIF. CIV. CODE § 1981 (now CALIF. LABOR CODE § 2856).

²⁷ 39 CORPUS JUR., *Master and Servant* § 86 (now 56 C.J.S. § 42(h) at 432-33); *Adams v. Southern Pacific Co.*, 204 Cal. 63, 266 Pac. 541 (1929). For later cases, see, *Seagram & Sons v. Bynum*, 191 F.2d 5, 17, 18 (8th Cir. 1951); *Albrecht v. N.L.R.B.*, 181 F.2d 657 (7th Cir. 1950); *Keserich v. Carnegie-Illinois Steel Corp.*, 163 F.2d 889 (7th Cir. 1947); *Compania Constructora Bechtel-McCone v. McDonald*, 157 F.2d 749 (9th Cir. 1946); *Steinmetz v. Calif. State Board of Education*, 44 Cal.2d 816, 285 P.2d 617 (1955).

²⁸ *Carpenter Steel Co. v. Norcross*, 204 Fed. 537 (6th Cir. 1913); *Park Bros. & Co. v. Bushnell*, 60 Fed. 583 (2d Cir. 1894); *Crabtree v. Bay State Felt Co.*, 227 Mass. 68, 116 N.E. 535 (1917); *Shaver v. Ingham*, 58 Mich. 649, 26 N.W. 162 (1886).

²⁹ *Development Co. v. King*, 161 Fed. 91 (2d Cir. 1908); *Marx v. Miller*, 134 Ala. 347, 32 So. 765 (1902); *Davis v. Dodge*, 126 App.Div. 469, 110 N.Y.S. 787 (1908); *Loos v. Walter Brewing Co.*, 145 Wis. 1, 129 N.W. 645 (1911); *Price v. Mouat*, 11 C.B. (N.S.) 508, 142 Eng. Rep. 895 (1862).

degree of expertness involved in their performance, as well as the baneful consequences flowing from services inferior to the established reputation of the artist, these principles have been given full recognition in theatrical cases.³⁰

To such an employment, the words of the Supreme Judicial Court of Massachusetts apply:

"Not every trivial breach of duty will warrant putting an end to the contract before the appointed time."³¹

Similar declarations have been made by other courts:

"A rule which might be perfectly applicable to the precision with which a coachman or gardener should be required to obey the direction of his master or mistress in regard to details of the service which involved the comfort of the household, might be inapplicable to the case of exact compliance by a manager of a large factory with a general rule which required him to render daily memoranda of his business life for the inspection of the directors."³²

"Willful disobedience, in the sense in which the word is used by the authorities, means *something more than a conscious failure to obey*. (Emphasis added.) It involves a wrongful or perverse disposition, such as to render the conduct unreasonable, and inconsistent with proper subordination. We are not prepared to hold that, even in what is known as menial service, every act of disobedience may be lawfully punishable by the penalty of dismissal and the serious consequence it entails upon the servant put out of place. . . .

"In such employments as involve a higher order of service, and some degree of discretion and judgment, it would in our opinion be unauthorized and unreasonable to regard skilled mechanics and other employes, as subject to the whim and caprice of their employers or as deprived of all right of action to such a degree as to be liable to lose their places upon every omission to obey orders, involving no serious consequences."³³

This is especially true where the nature of the employment is such that the employee's "*. . . reputation and his future good name and value (are) dependent upon his success. . . .*"³⁴ (Emphasis added.) *The obedience of an artist is, thus, not that of a menial.*³⁵

On the basis of the facts and legal principles outlined, I reached the conclusion that there was no breach of contract by the artist and that her continued employment, and moreover, acceptance of performance, after

³⁰ *Essanay Film Mfg. Co. v. Lerche*, 267 Fed. 353, 359 (9th Cir. 1920); *Baron v. Placide*, 7 La. Ann. 229 (1852); *Kelly v. Caldwell*, 4 La. Rep. (O.S.) 38 (1832); *Warner v. Rector of Holy Church*, 1 City Court Rep. 419 (N.Y. 1881); *Roserie v. Kiralfy Bros.*, 12 Phila. Rep. 209 (Penn. 1877). 1 LABATT, MASTER AND SERVANT 879 (2d ed. 1913).

³¹ *Crabtree v. Bay State Felt Co.*, 227 Mass. 68, 116 N.E. 535 (1917).

³² *Park Bros. & Co. v. Bushnell*, 60 Fed. 583 (2d Cir. 1894).

³³ *Shaver v. Ingham*, 58 Mich. 649, 26 N.W. 162 (1886).

³⁴ *Cook v. Stabb*, 1884-1896 Newfoundland Law Reports 240, 242.

³⁵ *Essanay Film Mfg. Co. v. Lerche*, 267 Fed. 353 (9th Cir. 1920). It was held there that a rejection of a comedy part, by an actress who had no experience in comedies, was "a reasonable objection on her part, whether considered as a protest or a refusal to play, and did not constitute a breach of contract on her part."

the alleged disagreements and arguments with the director constituted a waiver of any right to discharge. In the opinion of the California District Court of Appeals sustaining the judgment, emphasis is placed upon the fact that in the realm of artistic endeavor, a special type of obedience is required:

"Even in the most menial forms of employment there will exist circumstances justifying the servant in questioning the order of the master. . . . And when the employment is of the services of 'a special, unique, unusual, extraordinary and intellectual character,' as is agreed by the contract here under consideration, to be rendered 'conscientiously, artistically and to the utmost of her ability' sincere efforts of the artist to secure an artistic interpretation of the play, even though they may involve the suggestion of changes and the presentation of argument in favor of such changes, even though insistently presented, do not amount to wilful disobedience or failure to perform services under the contract, but rather a compliance with the contract which basically calls for services in the best interest of the employer."³⁶

The Supreme Court of California, in denying a hearing, stated:

". . . A perusal of the evidence discloses that in no instance was any final order of the employer disobeyed by the plaintiff and it cannot therefore be said that the conclusion of the District Court of Appeals that the findings are supported by the evidence is erroneous. It should be stated, however, that we do not wish it to be understood as approving any declaration in the opinion unnecessary to or inconsistent with this one ground of affirmance."³⁷

Granted that an artist cannot wilfully refuse to do what a contract calls for, these decisions use a realistic standard by applying to the acts of disobedience the test of reasonableness, consistent with the type of employment. In sum, if the matter as to which disobedience existed was one which might affect the artistic integrity of the artist, a test of *absolute* obedience to the will of the employer should not be applied.

III. The Law of Copyright

The publication, exhibition and representation of literary, artistic and dramatic works bring into play law federal in nature. So the greater development of these artistic endeavors in the West has had an impact on the development of the law on the subject. Ordinarily it is difficult, in dealing with a federal problem, to segmentize it and to show what federal courts in a particular region have done. However, it is a fascinating problem to see what contribution courts in a particular area have made to a subject and to equate it with general federal law. So the manner in which federal

³⁶ Goudal v. DeMille Picture Corp., 118 Cal.App. 407, 413, 414, 5 P.2d 432, 435 (1931).

³⁷ 118 Cal.App. 415, 7 P.2d 174 (1932). As the statement of the Court of Appeals which is cited in the text is part of the legal basis for sustaining the finding that the artist *did not disobey*, I do not believe that the Supreme Court disavowed the statement. If they did, I still consider it sound law.

courts in the Ninth Circuit have approached and solved some of these problems is now considered.

A. The Nature of Copyright Protection.

In dealing with this problem chief attention must be paid to the law of copyright enacted under the constitutional authorization of the Congress to enact legislation:

"(t)o promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their respective Writings. . . ."³⁸

The protection of "writings," after publication, is in addition to the proprietary right of the author in his manuscript, recognized at common law,³⁹ which is retained by the copyright law,⁴⁰ and which has already been discussed. Copyright confers the right of printing, multiplying or copying of original literary and artistic works and selling them to the exclusion of others.⁴¹ It is a monopoly "to prevent others from reproducing the copy-righted work."⁴²

The most recent revision of the American Copyright Act,⁴³ while recognizing this essential feature of copyright,⁴⁴ has named specifically some of the rights implicit in the copyright grant, such as translation,⁴⁵ reading in public,⁴⁶ presentation of dramatic work⁴⁷ and performance of a musical composition.⁴⁸ This codification has removed the doubts existing as to some of these matters. They do not concern us here except that their statement is necessary background for the discussion to follow.

³⁸ U.S. CONST. art. I, § 8.

³⁹ *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 346-49 (1908); *Warner Bros. Pictures v. Columbia Broadcasting System*, 216 F.2d 945, 948 (9th Cir. 1954).

⁴⁰ 17 U.S.C. § 2.

⁴¹ *Mazer v. Stein*, 347 U.S. 201, 218 (1954); *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 290-91; *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 281 Fed. 83, 94-95 (2d Cir. 1922); *Bobbs-Merrill v. Straus*, 147 Fed. 15, 19 (9th Cir. 1906).

⁴² *R.C.A. Mfg. Co. v. Whiteman*, 114 F.2d 86, 88 (2d Cir. 1940). We are not concerned in this study with the manner in which the courts have passed on questions relating to compliance with various requirements of the Copyright Act. It should be stated, however, that they have been rather liberal in interpreting the requirements as to notice. Indicative of this liberal attitude is the ruling that the sale of phonograph records of a musical composition did not terminate its copyright protection, *Yacoubian v. Carroll*, 74 U.S.P.Q. 275 (1947), and the fact that state courts have applied a long limitation period (two years) to plagiarism actions. *Italiani v. Metro-Goldwyn-Mayer Corp.*, 45 Cal.App.2d 464, 114 P.2d 370 (1941). For examples of attempts to control copyright by state law, see *WASH. REV. CODE* c. 19.24 (1951); *MONTANA LAWS* c. 90 (1937). For an example of the strict compliance with some of these statutes, insisted on by state courts, see *Taylor v. State of Washington*, 29 Wash.2d 638, 188 P.2d 671 (1948); *Buck v. Gallagher*, 307 U.S. 95 (1939); *De Marines, State Regulation of Musical Copyrights*, 6th Copyright Law Symposium (ASCAP), 1955, p. 118.

⁴³ 61 Stats. 652 (1947), 17 U.S.C. § 1.

⁴⁴ 17 U.S.C. § 1(a).

⁴⁵ 17 U.S.C. § 1(b).

⁴⁶ 17 U.S.C. § 1(c).

⁴⁷ 17 U.S.C. § 1(d).

⁴⁸ 17 U.S.C. § 1(e).

Originality in the law of copyright “. . . refers to the form of expression and not to the novelty of the subject matter.”⁴⁹ The courts in the Ninth Circuit have applied with great acumen the principle which protects the original expression of ideas. Some leading cases decided by the Court of Appeals for the Ninth Circuit will serve to illustrate both the positive and negative application of the principle.

The Harold Lloyd Corporation had copyrighted the photoplay “Movie Crazy” starring Harold Lloyd. Lloyd employed Clyde Bruckman to assist as a writer and director during the production of the play. Some ten years later, Universal Pictures Co., Inc. produced a motion picture entitled “So’s Your Uncle” and employed Bruckman as writer for that production. Plaintiff Lloyd brought an action against defendants Universal and Bruckman alleging infringement upon the copyright by virtue of incorporating into “So’s Your Uncle” fifty-seven consecutive scenes from “Movie Crazy” known as the “Magician’s Coat Sequence.” On appeal from the judgment in favor of the plaintiff, the court was called upon to determine several questions, the most important of which was whether a photoplay is a “dramatic work” within the meaning of section 1(d) of the Copyright Act. It held that it was. It then determined that the whole picture need not be copied to constitute infringement, adding: “The mere copying of a major sequence is sufficient.”⁵⁰

The problem of originality, although not very significant in the determination of the case, was also discussed. The court, applying the concept already alluded to that the law protects originality in the *means* of expression, said:

“In answer to the point that the sequence lifted is commonplace, we find no evidence that they had ever previously appeared in like combination, arrangement or form. The direct examination of Bruckman supports this ruling. The originality was displayed in taking commonplace materials and acts and making them into a new combination and novel arrangement which is protectible by copyright. . . .

“The means of expressing an idea is subject to copyright protection, and where one uses his own method or way of expressing his idea, such adornment constitutes a protectible work. It is true that the mere motions, voice and postures of actors and mere stage business is not subject of copyright protection, but the sequence in question has literary quality in that it contains a story and is dramatic composition.”⁵¹

⁴⁹ Chamberlin v. Uris Sales Corp., 150 F.2d 512, 513 (2d Cir. 1945). See, Funkhouser v. Loew’s, Inc., 208 F.2d 185, 189 (9th Cir. 1953); Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 101-02 (2d Cir. 1951); Ricker v. General Electric Co., 162 F.2d 141 (2d Cir. 1947); Dorsey v. Old Surety Life Ins. Co., 98 F.2d 872, 873 (10th Cir. 1938); Harold Lloyd Corp. v. Witwer, 65 F.2d 1, 24 (9th Cir. 1933); Ansehl v. Puritan Pharmaceutical Co., 61 F.2d 131, 135-136 (8th Cir. 1932). See, Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457, 482 (1951). The latest high judicial declaration on the subject is in Mazer v. Stein, 347 U.S. 201, 217, 218 (1954).

⁵⁰ Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354 (9th Cir. 1947).

⁵¹ *Id.* at 363. See Mazer v. Stein, *supra* note 49.

The converse of the principle, i.e., that similarity of incidents does not necessarily spell copying was treated in another case. A. C. Witwer had copyrighted an original story entitled "The Emancipation of Rodney." In an action brought by the administratrix of his estate, Sadie Witwer, the trial court found infringement, issued an injunction against the production of the play and ordered an accounting to determine the profits. The judgment was reversed, the court ruling that there was no similarity between the two plots and that whatever apparent similarity existed, was fortuitous and inherent in the situations with which both works dealt:

"We are of opinion that such similarities as exist between the play and the story, and there are many, are such as require analysis and critical comparison in order to manifest themselves. The outstanding feature, the climax of both story and play, is the football game, with necessarily some similarity, but there is nothing new and novel in that other than the unusual participation of the heroes in their respective games, and on analysis these are neither identical nor similar in scene nor in conception of the two productions, but, if this be doubted, as was done by the trial court, then it is clear that there is no such similarity as overcomes the positive testimony that there was in fact no copying. The circumstantial evidence derived from comparison of the two productions is not forceful or weighty enough to overcome the direct and positive and persuasive evidence to the contrary offered by the plaintiff herself. 'Unless the public is deceived by the pictures, and led to believe that the films are a picturization of plaintiff's literary work (the standard of the ordinary observer being applied) then no infringement is shown.' *Roe-Lawton v. Hal E. Roach Studios (D.C.)*, 18 F.(2d) 126, 128."⁵²

The "ordinary observer" test for determining presence or absence of similarity has been reaffirmed by the same court repeatedly.⁵³ I applied it in holding that there was no similarity in the manner of using a church as a scene for action between the motion picture "When Tomorrow Comes" and James M. Cain's copyrighted novel "Serenade."

"Was there what the cases call 'unconscious and unintentional copying?' . . . If we apply the only permissible test—similarity—as it is manifest to the ordinary reader of the book and observer of the picture, the sole and obvious answer must be negative.

"One need not deny originality to 'Serenade.' . . . Plaintiff, himself, concedes as much when he limits the alleged infringement to the church sequence. But, here, again, there is no similarity. . . . It suffices to say that it is inconceivable that the ordinary theater-goer, who saw the chaste, idyllic church sequence in 'When Tomorrow Comes,' of the two lovers who spent the night in the church choir loft, where they sought asylum from the storm, would see in it, in the manner of its development or in the means used to portray the period between their entry into the church to their rescue,

⁵² *Harold Lloyd Corp. v. Witwer*, *supra* note 49, at 28. For a more recent case in which no copying of any important sequence was found, see *Funkhouser v. Loew's, Inc.*, *supra* note 49, at 188.

⁵³ *Kustoff v. Chaplin*, 120 F.2d 551, 561 (9th Cir. 1941); *Twentieth Century-Fox Film Corp. v. Stonesifer*, 140 F.2d 579 (9th Cir. 1944); *Funkhouser v. Loew's, Inc.*, *supra* note 49.

any similarity between it and the sensuous scene which Cain portrays in 'Serenade.' I can see none. . . .

"It is not claimed that the choice of the church as a refuge in storm lends itself to the assertion of copyrightable originality. Houses of worship have been asylums since their very beginning. At one time, the legal privilege of sanctuary attached to churches. And he who entered one of them acquired immunity against the law.

"The other small details, on which stress is laid, such as the playing of the piano, the prayer, the hunger motive, as it is called, are inherent in the situation itself. They are what the French call 'scenes à faire.' One having placed two persons in a church during a big storm, it was inevitable that incidents like these and others which are, necessarily, associated with such a situation should force themselves upon the writer in developing the theme."⁵⁴

The cases just discussed used a pattern for determining originality and testing infringement which is universally accepted.⁵⁵ They have been applied consistently through the circuit, to a great variety of intellectual products, some of which rank rather low in artistic, literary or dramatic value. Illustrative are: decorative design,⁵⁶ directories,⁵⁷ distinctive title or distinctive human type,⁵⁸ maps,⁵⁹ musical compositions,⁶⁰ photographs,⁶¹ plays and stories,⁶² and poems.⁶³ But originality and therefore copyrightability have

⁵⁴ *Cain v. Universal Pictures Co.*, 47 F. Supp. 1013, 1016 (S.D. Cal. 1942). See also *De Montijo v. Twentieth Century-Fox Film Corp.*, 40 F. Supp. 133 (S.D. Cal. 1941); *Seltzer v. Sunbrock*, 22 F. Supp. 621, 628 (S.D. Cal. 1938). It was decided in a case involving a similar problem that the use of the Hollywood Bowl as the locale for a story was not the subject of a claim of proprietorship, *James v. Universal Pictures Corp.* (Cal. Superior Court), *Los Angeles Journal*, Dec. 8, 1928. And see *Schwarz v. Universal Pictures Co.*, 85 F. Supp. 270 (S.D. Cal. 1945) for an extended treatment of this topic.

⁵⁵ See note 49 *supra*.

⁵⁶ *Malsed v. Marshall Field & Co.*, 96 F. Supp. 372 (W.D. Wash. 1951).

⁵⁷ *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (9th Cir. 1937).

⁵⁸ *Warner Brothers Pictures v. Columbia Broadcasting System*, 102 F. Supp. 141 (S.D. Cal. 1951); *Paramore v. Mack Sennett, Inc.*, 9 F.2d 66 (S.D. Cal. 1925). But see *Chamberlain v. Columbia Pictures*, 185 F.2d 922 (9th Cir. 1951), where the court declined to enjoin the association of Mark Twain's name with a story in the public domain.

⁵⁹ *Christianson v. West Publishing Co.*, 53 F. Supp. 454 (N.D. Cal. 1944); *Blackburn v. Southern California Gas Co.*, 14 F. Supp. 553 (S.D. Cal. 1936); *Chamberlin v. Bekins Van & Storage Co.*, 23 F. 2d 541 (S.D. Cal. 1928).

⁶⁰ *Overman v. Loesser*, 205 F.2d 521 (9th Cir. 1953); *Turner & Dahnken v. Crowley*, 252 Fed. 749 (9th Cir. 1918); *Carew v. R.K.O.*, 43 F. Supp. 199 (S.D. Cal. 1943); *Hirsch v. Paramount Pictures*, 17 F. Supp. 816 (S.D. Cal. 1937); *Buck v. Milam*, 32 F. 2d 622 (D.C. Idaho 1929); *Waterson, Berlin & Snyder Co. v. Tollefson*, 253 Fed. 859 (S.D. Cal. 1918); *Broder v. Zeno Mauvais Music Co.*, 88 Fed. 74 (N.D. Cal. 1898); *Rich v. Paramount Pictures*, 130 Cal.App.2d 775, 279 P.2d 782 (1955); *Blanc v. Lantz*, 83 U.S.Pat.Q. 137 (Superior Ct. Los Angeles County 1949). *Broder v. Zeno Mauvais Music Co.*, *supra*, is interesting in holding that "indecent" words in a song make it uncopyrightable. The subject of immorality in copyrighted material is also treated in *Cain v. Universal Pictures Co.*, *supra* note 54. See *Ted Fair, Publication of Immoral and Indecent Works*, 5th Copyright Law Symposium (ASCAP), 1954, p. 230. And see *Supreme Records v. Decca*, 90 F. Supp. 904 (S.D. Cal. 1950), for a discussion of the rights to musical arrangement. For comment, see, *Netterville, California Law of Unfair Competition*, 28 So. CALIF. L. REV. 241, 278-279 (1944).

⁶¹ *Journal Publishing Co. v. Drake*, 199 Fed. 572 (9th Cir. 1912).

⁶² *Hazard v. Columbia Broadcasting System*, 150 F.2d 852 (9th Cir. 1945); *Twentieth Century-Fox Film Corp. v. Stonesifer*, 140 F.2d 579 (9th Cir. 1944); *Stonesifer v. Twentieth Century-Fox Film Corp.*, 48 F. Supp. 196 (S.D. Cal. 1942); *Barbadillo v. Goldwyn*, 42 F.2d 881 (S.D. Cal. 1930).

⁶³ *Corcoran v. Montgomery Ward & Co.*, 121 F.2d 572 (9th Cir. 1941). In this case it was

been denied to books rebound and sold,⁶⁴ description of a spectacle or game,⁶⁵ stories describing wild horses,⁶⁶ claim of copyright to "spirit" messages received by prior author of book now dead,⁶⁷ claim to exclusive use of historical event,⁶⁸ advertising slogans using ordinary descriptive words.⁶⁹

B. Criminal Prosecution for Copyright Infringement.

An interesting aspect of the problem is the fact that in one of the rare prosecutions under the penal provisions of the Copyright Act,⁷⁰ in which Groucho and Chico Marx were convicted of infringing and aiding the infringement of a copyrighted production, the Court not only sustained the constitutionality of the criminal provision—which, although a part of the law for many years, has not been used very often—but also applied to the facts in the case the rule of similarity applicable in civil actions for infringement:

"It is urged that there was a fatal variance between the copyrighted work charged to have been pirated and the version of it which was in fact shown to have been broadcast.

"There was no substantial variance. The basic situation in the copyrighted material and in the script broadcast was the same. The development of the idea and the manner of expression were not only markedly similar, but were in many respects substantially identical. The law is well established that where the labors of an author are substantially and injuriously appropriated by another, an infringement occurs. *Dymow v. Bolton*, 2 Cir., 11 F.2d 690.

"Such variance as existed did not prejudice the rights of the accused. The indictment definitely informed them of the charge and of the time and circumstances of the claimed infringement. They were in no way misled in the preparation of their defense. Nor is the variance such as to deprive accused of protection against another prosecution for the same offense."⁷¹

C. Infringement by Parody.

Judge James M. Carter, of the 9th Circuit, in an action instituted by Loew's, Inc. against Columbia Broadcasting System, American Tobacco

held that the production of the words of a poem in combination with music was not a dramatization of the poem and did not infringe the author's copyright.

⁶⁴ *Bureau of National Literature v. Sells*, 211 Fed. 379 (W.D. Wash. 1914).

⁶⁵ *Seltzer v. Sunbrock*, 22 F. Supp. 621 (S.D. Cal. 1938); *Martinetti v. Maguire*, 16 Fed. Cas. 920 (Cal. 1867). See, *Maddux v. Grey*, 43 F.2d 441 (S.D. Cal. 1930), denying infringement in a novel of a description of a buffalo hunt, claimed to have been contained in an autobiographical book; *Taylor v. Metro-Goldwyn-Mayer Studios*, 115 F. Supp. 156 (S.D. Cal. 1953), denying proprietary rights in a particular arrangement of cameras and lights, producing certain specific effects; *Long v. Jordan*, 29 F. Supp. 287 (N.D. Cal. 1939), denying originality to the description of a pension plan.

⁶⁶ *Roe-Lawton v. Hal E. Roach Studios*, 18 F.2d 126 (S.D. Cal. 1927).

⁶⁷ *Oliver v. St. Germain Foundation*, 41 F. Supp. 296 (S.D. Cal. 1941).

⁶⁸ *De Montijo v. Twentieth Century-Fox Film Corp.*, 40 F. Supp. 133 (S.D. Cal. 1941); *Echevarria v. Warner Brothers*, 12 F. Supp. 632 (S.D. Cal. 1935).

⁶⁹ *Laskowitz v. Marie Designer*, 119 F. Supp. 541, 552 (S.D. Cal. 1954). See *Simms v. Stanton*, 75 Fed. 6 (N.D. Cal. 1896), upholding as "fair use" the copying of certain material in a book on physiognomy drawn from a common source.

⁷⁰ 17 U.S.C. § 28 (1946), now 17 U.S.C. § 104 (1947).

⁷¹ *Marx v. United States*, 96 F.2d 204, 207 (9th Cir. 1938).

Company and the well-known comedian, Jack Benny, recently enjoined the performance of a humorous sketch, "Auto Lite," burlesquing the motion picture "Gas Light," the property of Loew's.⁷²

The problem of burlesquing and parody has been treated fully by the writer elsewhere.⁷³ However, the following observations may be made on the case just referred to.

While the conclusion reached can be justified on the basis of the facts presented, there is ground for disagreement with the theory to which the opinion gives assent, namely, that in order to determine plagiarism, parody or burlesque should be judged in the same manner as actual or serious taking. For, under a rigid application of this criterion—measured by the rule of substantial taking—parody or burlesque would almost always infringe. Under the law of actual taking, the appropriation of even two or three scenes constitutes infringement.⁷⁴ If this test were applied, it would, in many instances, deny altogether the application of the doctrine of fair use to parody or burlesque. In other cases, it would contract the concept unjustifiably. Parody or burlesque, viewed in their historical perspective, do not justify this approach which might result in denying to it the status of a distinct literary *genre*, which it has had in the Anglo-American world of letters, both before and after the enactment of the copyright Statute of Anne in 1710.

But to return to the general topic. One fact is significant—the courts consider the determination of the question of originality and infringement as a question of *fact*,⁷⁵ as to which, in proper cases, a jury trial should be had.⁷⁶ Summary judgment or judgment on the pleadings will be sustained only where the copyrighted work and the infringing work are both before the court and the *only* question is similarity.⁷⁷

D. Rights and Duties.

Novel questions have arisen as to the nature of the right conferred by copyright and the transfer of such right. Some years ago we were asked to determine what constituted a "general publication" of a manuscript. Under the same facts, the Court of Appeals and I reached opposite conclu-

⁷² Loew's, Inc. v. Columbia Broadcasting System, 131 F. Supp. 165, 105 U.S.Pat.Q. 304 (S.D. Cal. 1955).

⁷³ Yankwich, *Parody and Burlesque in the Law of Copyright*, CAN. B. REV. (Dec. 1955); Yankwich, *What Is Fair Use?*, 22 U. CHI. L. REV. 203; Cohen, *Fair Use in the Law of Copyright*, 6th Copyright Law Symposium, 1955, pp. 43, 54-57.

⁷⁴ Heim v. Universal Pictures Co., 154 F.2d 480, 487 (2d Cir. 1946); Arnstein v. Porter, 154 F.2d 464, 468-469 (2d Cir. 1946); Kustoff v. Chaplin, 120 F.2d 551, 560 (9th Cir. 1941); Chappell & Co. v. Fields, 210 Fed. 864, 865-866 (2d Cir. 1914); Annot., 23 A.L.R.2d 244, 337-339 (1950).

⁷⁵ Dezendorf v. Twentieth Century-Fox Film Corp., 99 F.2d 850 (9th Cir. 1938).

⁷⁶ Bruckman v. Hollzer, 152 F.2d 730 (9th Cir. 1946).

⁷⁷ Christianson v. West Publishing Co., 149 F.2d 202 (9th Cir. 1945); Piantadosi v. Loew's, Inc., 137 F.2d 534 (9th Cir. 1943). See note 13 *supra*, for comment on California statutory provision (CALIF. CODE OF CIV. PRO. § 426(3)) which facilitates determination by comparison without trial.

sions. I held that a publication of a manuscript dealing with philosophical ideas limited to a few *adherents* of the philosophy did not constitute a general publication.⁷⁸ The Court of Appeals, upon the same facts, reached a contrary conclusion.⁷⁹

As the right conferred by the copyright statute is federal in nature, do the federal courts have the right to entertain proceedings to foreclose a mortgage on the copyright? I held that they did.⁸⁰ In view of the fact that the copyright statute specifically authorizes chattel mortgages on copyrights,⁸¹ the Court of Appeals for the Second Circuit in interpreting the section, held that copyrights can be mortgaged *only* under the federal copyright law.⁸² But our own Court of Appeals held that foreclosures must be had in the state courts.⁸³

Vexing problems relating to the transfer of rights to copyrighted material have arisen. Our courts have held that an assignment of all rights in a story to a motion picture concern does not imply a warranty of marketable title.⁸⁴ But the grant by an artist to his producer of the right to his services for motion picture purposes, including the right to photograph and reproduce "his acts, poses, plays or appearances," carries the right to exercise the ". . . ownership and rights to the product of artist's employment whether or not such exercise involves exhibition of the subject motion pictures in connection with commercial advertising."⁸⁵ And the same words in the contract of another motion picture artist were held not to prohibit the producer from cutting the performances to a shorter length and "showing them in connection with commercial advertising over television."⁸⁶

⁷⁸ *White v. Kimmell*, 94 F. Supp. 502 (S.D. Cal. 1950).

⁷⁹ *White v. Kimmell*, 193 F.2d 744 (9th Cir. 1952).

⁸⁰ *Republic Pictures v. Security First National Bank*, 97 F. Supp. 360 (S.D. Cal. 1951).

⁸¹ 17 U.S.C. § 28 (1947).

⁸² *In re Leslie-Judge Co.*, 272 Fed. 886 (2d Cir. 1921). California state courts have held that a patent right, being incorporeal in nature, is not subject to execution under state law. *Peterson v. Sheriff of San Francisco*, 115 Cal. 211, 46 Pac. 1060 (1896); *Pacific Bank v. Robinson*, 57 Cal. 520; 40 Am. Rep. 120 (1881).

⁸³ *Republic Pictures v. Security First National Bank*, 197 F.2d 767 (5th Cir. 1952).

⁸⁴ *Loew's, Inc. v. Wolff*, 101 F. Supp. 981 (S.D. Cal. 1951), affirmed on basis of this opinion in *Loew's, Inc. v. Wolff*, 215 F.2d 651 (9th Cir. 1951).

⁸⁵ *Rogers v. Republic Productions*, 213 F.2d 662, 666 (9th Cir. 1954). See note 19 *supra*. See also *Wexley v. KTTV*, 108 F. Supp. 558 (S.D. Cal. 1952), in which a grant of rights to a dramatic composition including all motion picture rights was held to convey the right to televise the motion picture. The rule was affirmed by the Court of Appeals, the court stating its agreement with the opinion and its reasoning, *Wexley v. KTTV*, 220 F.2d 438 (9th Cir. 1955).

⁸⁶ *Autry v. Republic Pictures*, 104 F. Supp. 918 (S.D. Cal. 1952), affirmed in *Autry v. Republic Pictures*, 213 F.2d 667 (9th Cir. 1954). This case is in line with others in which the words in contracts have been given broad interpretations to cover contingencies which *may not have existed* at the time, but could clearly have been anticipated. Thus, the transfer of motion picture rights was held to include the right to produce talking pictures, *Murphy v. Warner Brothers*, 112 F.2d 746 (9th Cir. 1940). See note 19 *supra*. In *United Artists Corp. v. Strand Productions*, 216 F.2d 305 (9th Cir. 1954), a contract between a distributor and a producer regarding distribution was interpreted to grant the right to exploit motion picture films in the television field, either directly or through others. As to the federal nature of radio broadcasting as it bears on the right to tax locally, see *McCaw v. Fase*, 216 F.2d 700 (9th Cir. 1954).

IV. *Personal Relationships*

In treating state law, we discussed the attitude of courts towards the relationship of master and servant as expressed both in the legislation and jurisprudence of the state courts. A most interesting problem has arisen with what is commonly known as the "morality clause" in motion picture contracts. For years—and at a time when motion picture producers were concerned not with the political but with other extra-curricular *social* activities of artists which might reflect on them and their product—there has been inserted into the contracts of employment of actors and writers a clause which reads substantially as follows:

"The employee agrees to conduct himself with due regard to public conventions and morals and agrees that he will not do or commit any act or thing that will tend to degrade him in society or bring him into public hatred, contempt, scorn or ridicule, or that will tend to shock, insult or offend the community or ridicule public morals or decency, or prejudice the producer or the motion picture, theatrical or radio industry in general."

Lester Cole, a writer for Metro-Goldwyn-Mayer, was discharged on December 2, 1947, by notice which stated, in substance, that by his conduct during his appearance before the House Un-American Activities Committee on October 30, 1947, he had violated this clause. He brought action for declaratory judgment, which was tried before a jury. The chief interrogatories submitted to the Jury and their answers were:

"(1) Did the plaintiff Lester Cole, by his statements and conduct before the House Committee on Un-American Activities, in connection with the hearing held by said Committee, bring himself or tend to bring himself into public hatred, contempt, scorn and ridicule?

"Answer: No.

"(2) Did the plaintiff Lester Cole, by his statements and conduct before the House Committee on Un-American Activities, in connection with the hearing held by said Committee, tend to shock, insult or offend the community?

"Answer: No.

"(3) Did the plaintiff Lester Cole, by his statements and conduct before the House Committee on Un-American Activities in connection with the hearing held by said Committee, prejudice the defendant Loew's Incorporated as his employer or the motion picture industry generally?

"Answer: No.

"(4) Did the defendant Loew's Incorporated by its conduct towards the plaintiff, subsequent to the hearing, waive the right to take action against him by suspending him?

"Answer: Yes."

On the basis of these special verdicts and because I agreed with them, I gave judgment in favor of Cole for the salary due him during the period of his wrongful discharge. The opinion which was delivered at the time

and the Findings which followed stated that the "morality clause" had not been violated, and that the company by their actions—by continuing Cole in their employ after his appearance before the congressional committee and, especially, by increasing his salary and discussing with him new assignments—had countenanced and condoned his conduct and thus waived the breach.⁸⁷

The Court of Appeals disagreed. They held that the effect of Cole's conduct on public opinion should have been gone into more fully and that the acts of the employers were not a waiver, saying:

"We think that it cannot be said as a matter of law that these facts, uncontroverted as they are, establish either that there was a practical construction of the contract as having the meaning appellee says should be attached to it, or that there had been a waiver of performance in advance. Restatement of the Law of Contracts, Sec. 297."⁸⁸

These questions came again before the Court of Appeals in 1954 upon a judgment rendered in favor of another writer, Ring Lardner, another one of "the Hollywood Ten," who, in 1947, had declined to answer questions of the House Un-American Activities Committee. This was an action for damages tried by another judge before a jury. Here, again, the jury rendered a verdict in favor of the writer. Lardner's contract contained a similar morality clause which the Court of Appeals characterized as containing: "everything that Cole's said and a little more."⁸⁹ Again the court ruled that the acceptance of performance by the company for a short period of time did not amount to a waiver and that informal statements by some of the men in authority as to Lardner's continuance of performance of the contract lacked authorization.

A reading of the two opinions leaves the definite impression that the effect of the conduct before the House Un-American Activities Committee which, in 1950, was considered in the Cole case a *question of fact*, became almost a *legal presumption* in the Lardner case in 1954. Acts done in 1947 relating to so sensitive a subject as suspected Communism or Communist activities, are difficult to evaluate in the climate of later years. Nevertheless, it should be observed that both cases were tried before juries, and identical decisions were reached. The atmosphere of tension existing at the time the cases were decided by the Court of Appeals did not exist when the incidents occurred or when the cases were tried. One wonders if this did not affect final determination. Revealing is the fact that early in 1955, the Supreme Court of California refused to give effect to an award of damages by an Arbitration Board made in favor of a woman employee for wrongful discharge, under an arbitration provision contained in a collective bargaining agreement,

⁸⁷ Cole v. Loew's, Inc., 8 F.R.D. 508 (S.D. Cal. 1948).

⁸⁸ Loew's, Inc., v. Cole, 185 F.2d 641, 652 (9th Cir. 1950).

⁸⁹ Twentieth Century-Fox Film Corp. v. Lardner, 216 F.2d 844, 848 (9th Cir. 1954).

upon the ground that the employee's membership in the Communist Party justified her discharge by the employer—a laboratory which manufactured and sold throughout the United States vaccines, serums, anti-toxins and other antibiotics for both civilian and military use.⁹⁰

It is wise social policy to be alert against any totalitarian doctrines subversive to our ideals. I have had occasion to express concern over the matter.⁹¹ And more recently, I ruled that concealment of membership in the Communist Party was a fraud on the government under the Naturalization and Immigration Act of 1940.⁹² One wonders if we are right in reading these anxieties into private contracts of employment in order to justify breaches of contracts of employment which create in private employment a caste of pariahs to whom we, in effect, deny the equal protection of our laws.⁹³

Conclusion

On the whole, it must be said that the West, both legislatively and juristically (and as to the latter, both through state and federal courts), has approached the problems created by the transfer of activities in certain areas of artistic endeavor intelligently. They have applied with noted acumen old principles to new conditions and have sought to evolve new principles where the old ones were found inadequate. In all these matters, there was an attempt to attain feasible goals and to conform to the spirit of growth which is characteristic of American law and to that spirit of moderation, equity and fair play which is a tradition of our American life. If the endeavor has not always been successful and the end product not always wise, the fault lies in the fact that the instrumentalities with which these results were achieved—be they legislators, or judges—are human and subject to the actions, and, implicitly, the frailties, passions and prejudices of the society, and the times, in which they live. Absolute detachment is not

⁹⁰ *Black v. Cutter Laboratories*, 43 Cal.2d 788, 278 P.2d 905 (1955), *cert. granted*, 350 U.S. 816 (1955).

⁹¹ YANKWICH, *THE CONSTITUTION AND THE FUTURE*, 20-23 (1935); YANKWICH, *NATURE OF OUR FREEDOM*, 81 et seq. (1950).

⁹² *United States v. Title*, 132 F. Supp. 185 (S.D. Cal. 1955).

⁹³ The trend of recent judicial opinion makes this warning very timely. The Court of Appeals for the Ninth Circuit has held that "screen credit" whereby there is indicated on a motion picture the name of the author of the script is a valuable contractual right, the denial of which by a producer warrants a substantial award of damages. *Paramount Productions v. Smith*, 91 F.2d 863 (9th Cir. 1937). Nevertheless, California courts have held that the failure of a writer to deny charges before a House Committee on Un-American Activities attacking him as a communist warranted denial to the writer of screen credit by the producer. *R.K.O. v. Jarico*, 128 Cal.App.2d 172, 274 P.2d 928 (1954). One of the superior courts of California has ruled that such refusal warranted the producers in establishing a "blacklist" by declining to hire, and inducing others not to hire persons who either refused to testify at all or claimed the constitutional immunity against self-incrimination. The complaint, which was dismissed, sought redress for malicious interference with "economic relations" affecting "the fundamental right to work for a living," *Brown v. Loew's, Inc.*, *Los Angeles Daily Journal Reports*, Vol. 5, No. 9, p. 282.

always humanly attainable. A wise and realistic English Judge wrote in 1769:

"It is wise in any state, to encourage letters, and the painful researches of learned men. The easiest and most equal way of doing it is by securing to them the property of their own works. Nobody contributes, who is not willing; and though a good book may be run down, and a bad one cried up, for a time; yet sooner or later, the reward will be in proportion to the merit of the work.

"A writer's fame will not be the less, that he has bread, without being under the necessity of prostituting his pen to flattery or party, to get it."⁹⁴

So it may be said that, while the law makers of the West may have impressed their judgments with some of the prejudices of the day, on the whole, and especially in protecting the property rights of creators engaged in intellectual activities, they have struck a wise balance between the desire to reward materially those exercising the creative spirit and the primary constitutional aim to insure to our society the great advantage which flows from the encouragement of the arts and sciences.⁹⁵

⁹⁴ Mr. Justice Willes in *Millar v. Taylor*, 4 Burr. 2303, 2335, 98 Eng. Rep. R. 201, 218 (1769).

⁹⁵ *Mazer v. Stein*, 347 U.S. 201, 219 (1954). See also, *Ballentine v. De Sylva*, 266 F.2d 623 (9th Cir. 1955), indicating the attempt of the court to envisage in a forthright manner the odd realities which human relationships, stemming from copyright, bring to their attention. The court was confronted with two problems. The first was whether, under 17 U.S.C.A. § 24, the widow of an author is in a class with a child so far as the rights of renewal and extension of copyright is concerned. As to this, the court reached the conclusion that the rights of the widow and the children are expressed in the alternative—which means that either one or the other "may act for the family which consists of the widow or widower and all of the children." In this respect, the conclusion reached is rather restrictive. However, the other question submitted solved it in a very humane manner. The court had before it the assertion of the right to renew or extend a copyright on behalf of the illegitimate child of a writer, who had been acknowledged as his during his lifetime, but had never been legitimized under California law. Disregarding the harsh attitude towards illegitimacy of the common law, and the older cases which interpret the word "child" when used in instruments relating to the conveyance or descent of property, to mean a "legitimate" child, the court held that the word "child" in the section referred to would apply to an illegitimate child. In this manner, the right to renew and extend the copyright was granted to an illegitimate child, thus preventing the copyrighted song from falling into the public domain.